

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB
12/22/97

RFC

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Warnaco, Inc.**

Serial No. 74/699,563

Nancy M. Dodderidge of Amster, Rothstein & Ebenstein for
Warnaco, Inc.
Leslie Bishop, Trademark Examining Attorney, Law Office 109
(Deborah Cohn, Managing Attorney).

Before **Cissel**, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On July 7, 1995, applicant filed an application to register the mark "SATIN EMBROIDERIES" on the Principal Register for "women's intimate apparel, namely, bras, panties, bustiers, briefs, slips, corsettes and camisoles," in Class 25. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce on the specified goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Act on the ground that the mark, if

applied to the goods set forth in the application, would be merely descriptive of them. In support of the refusal, the Examining Attorney submitted a copy of a page from the 1994 edition of the Webster's II New Riverside Dictionary, which shows that satin is "a smooth fabric, as of silk, nylon, or rayon, with a glossy face and a dull back." The term "satin stitch" is defined in the same dictionary as "[a]n embroidery stitch done in close parallel lines to produce a satinlike finish."

On the basis of the meanings of the two words in the mark sought to be registered, the Examining Attorney concluded that the proposed mark would immediately convey to prospective purchasers of applicant's goods that the clothing items bearing the mark either would be made of satin and decorated with embroidery, or that the embroideries on the goods would have a satin finish, such as that produced by satin stitch embroidery. The Examining Attorney found that in either event, the term sought to be registered is unregistrable under Section 2(e)(1) of the Act because it immediately conveys information about the nature, characteristics or features of the goods to which it will be applied.

Applicant argued that registration was not barred by the statute, but submitted no evidence in support of its contentions. The Examining Attorney was not persuaded by

applicant's arguments, and the refusal to register was made final in the second office action. Applicant requested reconsideration, again without making any evidence of record in connection with its arguments. Again the Examining Attorney remained convinced that the refusal was proper, and applicant filed a notice of appeal to this board.

Applicant filed its appeal brief. In the brief, applicant listed several third-party registrations it contended supported a finding that applicant's mark is only suggestive as applied to the goods set forth in the application, but copies of these registrations were not submitted with the brief. The Examining Attorney filed her brief responsive to applicant's brief, including an objection to the untimely submission by applicant of the list of third-party registrations in applicant's brief. Attached to the Examining Attorney's brief was a photocopy of another page from the same dictionary she had previously copied. This time the entry for "embroidery" was shown. One listed meaning is "ornamentation of fabric with needlework."

Next, applicant petitioned for suspension of the appeal and restoration of jurisdiction to the Examining Attorney for consideration of additional evidence, namely copies of printouts from a commercial data base showing the third-party registrations applicant had listed in its brief. This

submission was followed a week later by actual copies of the registrations at issue.

Because the registrations were not timely submitted, the Board denied applicant's request to make the copies of record in this application as well as applicant's request for suspension of action on the appeal and remand to the Examining Attorney for consideration of them. The Board pointed out that under Trademark Rule 2.142(d), the record in an application is closed with the filing of the notice of appeal. Accordingly, we have not considered the evidence applicant sought to make of record. Moreover, even if we had, our decision in this case would not have been different from the one we have reached without considering the evidence in question. The issue here is not whether other marks which include the term "SATIN" combined with different terms, none of which is "EMBROIDERIES," are merely descriptive of the various clothing items listed in the third-party registrations untimely submitted by applicant. Rather, the issue before us in this appeal is whether the mark "SATIN EMBROIDERIES" is merely descriptive of the goods specified in the instant application.

Based on careful consideration of the record in this application and the relevant legal principles and precedents, we hold that the mark applicant seeks to

register is merely descriptive of the goods set forth in the application.

A mark is merely descriptive under Section 2(e)(1) of the Act if it immediately conveys information about an ingredient, quality, characteristic, or feature of the goods with which it is, or will be, in the case of an application based on the intent to use the proposed mark, used. In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). The question is not whether one could determine what the goods are from consideration of the mark in the abstract. Rather, we must determine whether the mark conveys descriptive information in relation to the identified goods in the context in which the mark is, or will be, used in connection with the goods, and the possible significance which the mark would have, in that context, to the typical purchaser of the goods in the marketplace where such goods are normally sold. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Further, that a term may have other connotations that are not descriptive of features or characteristics of the goods in question does not overcome the fact that one meaning attributable to the term is merely descriptive in connection with the goods. In re Bright-Crest, supra; In re Hycon Mfg. Co., 169 USPQ (TTAB 1971).

We disagree with applicant's conclusion that prospective purchasers of these items of women's apparel would not understand the mark to describe characteristics of applicant's products. Purchasers probably would not be able to draw accurate conclusions about the nature of applicant's goods from consideration of the mark by itself, but when these people consider the mark in connection with the goods set forth in the application, we agree with the Examining Attorney that they would immediately understand, without resorting to imagination or mental gymnastics, either that applicant's garments are made of satin and decorated with embroidery, or that the embroidery on the goods has a satin finish, such as the finish produced by satin stitch embroidery. This is a reasonable conclusion based on the ordinary meanings of the two words, as shown by the dictionary evidence submitted by the Examining Attorney, and applicant has not made of record anything that leads us to a different conclusion.

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Accordingly, the refusal to register under Section
2(e)(1) of the Act is affirmed.

R. F. Cissel

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges
Trademark Trial & Appeal Board

A.

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